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Docket No.: PC-0037 US

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By: _____ Printed: Katherine Stofer

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Lal et al.

Title: STEAP-RELATED PROTEIN

Serial No.: 09/802,520 Filing Date: March 09, 2001

Examiner: Davis, M. Group Art Unit: 1653

#12
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9-12-02

Box Non-Fee Amendment
Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO RESTRICTION REQUIREMENT UNDER 35 U.S.C. 121

Sir:

This paper is responsive to the Restriction Requirement and Request for Election dated July 9, 2002, setting a one (1) month term for response.

In the Restriction Requirement, the Examiner stated that Applicant's election of Group I and amendment of claim 17 in the previous response filed April 19, 2002 is acknowledged, however, that after review and consideration, claims 1-20 require further restriction as follows:

Group I (claims 1-6) drawn to a nucleic acid sequence of SEQ ID NO:2, or a nucleic acid sequence encoding SEQ ID NO:1, fragments selected from SEQ ID NO:3-9, a vector comprising a nucleic acid sequence encoding SEQ ID NO:1, a host cell, and a method of making a protein.

Group II (claims 1-6) drawn to a nucleic acid sequence of which is a variant of SEQ ID NO:2, comprising SEQ ID NO:10, or a complement thereof, a vector comprising SEQ ID NO:10, a host cell, and a method of making a protein.

Group III (claims 7 and 9) drawn to a method for detecting expression of a nucleic acid.

Group IV (claim 8) drawn to a method for detecting expression of a nucleic acid using amplification.

Group V (claim 10) drawn to a method for detecting prostate hyperplasia.

Group VI (claim 10) drawn to a method for detecting prostate cancer.

Group VII (claims 11-12) drawn to a method for screening compounds that bind specifically to a nucleic acid encoding SEQ ID NO:1.

Group VIII (claims 13-14) drawn to a protein of SEQ ID NO:1, or fragments thereof.

Group IX (claims 15-16) drawn to a method for screening compounds that specifically bind SEQ ID NO:1.

Group X (claim 17) drawn to an antibody specific for SEQ ID NO:1 or an antigenic epitope or biologically active portion thereof.

Group XI (claim 18) drawn to a method for producing said antibody using SEQ ID NO:1, or an antigenic epitope or biologically active portion thereof.

Group XII (claims 19-20) drawn to a method for detecting prostate hyperplasia using an antibody.

Group XIII (claims 19-20) drawn to a method for detecting prostate cancer using an antibody.

The Examiner has further required that, upon election of Group I, further election of the following species is required:

Any one of SEQ ID NOs:3-9.

Upon election of Group VII, further election of any one of the molecules recited in claim 12.

Upon election of Group IX, further election of any of the molecules in claim 16.

Applicants hereby elect, with traverse, to prosecute Group I, which includes and is drawn to Claims 1-6. Applicants further elect the species of SEQ ID NO:3, again with traverse. Applicants reiterate arguments previously presented in Paper No. 8, filed on April 9, 2002 regarding the excessive and inappropriate restriction of claims. SEQ ID NOs:3-9 and SEQ ID NO:10 are described in the specification as component sequences of SEQ ID NO:2 and a variant of SEQ ID NO:2 having 85% sequence identity to SEQ ID NO:2, respectively. Clearly these sequences would be found in any search for sequences related to SEQ ID NO:2 or other sequences encoding SEQ ID NO:1. Applicants reiterate that appropriate restriction according to the MPEP § 803 requires both that the

inventions be patentably distinct, and that there must be a serious burden of search on the Examiner if restriction is required. The Examiner has presented no evidence that the examination of SEQ ID NOs:2-10 would pose a serious burden of search for the reasons noted above. In addition, the restriction of claims 7-12, reciting methods of use of the polynucleotides of Group I, into separate groups is also unnecessary because, as noted by the Examiner, all of Groups III-VII are classified the same (e.g., class 435, and specifically subclass 6) and would involve the same search. Since these methods also depend from and are of the same scope as the polynucleotides of Group I, Applicants further submit that they could be examined together with the composition of matter claims from which they depend, again without undue burden. The Examiner's request for election of a single molecule or compound in Groups VII and IX also misrepresents the concept of election of species. Applicants submit that the patentable distinctiveness of the molecules or compounds are not an issue for examination purposes of the claims at issue as the claims are to a method of use of the compositions of Groups I and not to the species themselves. Finally, Applicants submit that regardless of restriction, claims 7-12 representing methods of use of the polynucleotides of Group I that depend from and are of the same scope as the polynucleotide claims of Group I are subject to rejoinder and examination on allowance of the claims of Group I in accordance with *Ochiai and Brouwer* (see Commissioner's Notice in the Official Gazette of March 26, 1996).

Accordingly, Applicants request reconsideration of the Restriction Requirement and examination of claims 1-12 in Groups I-VII with respect to all recited species. In the event that the Examiner maintains the Restriction Requirement, Applicants reserve the right to prosecute the subject matter of non-elected claims in subsequent divisional applications.

Applicants believe that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. 09-0108.

Respectfully submitted,

INCYTE GENOMICS, INC.

Date: July 31, 2002

David G. Streeter, Ph.D.
Reg. No. 43,168
Direct Dial Telephone: (650) 845-5741

3160 Porter Drive
Palo Alto, California 94304
Phone: (650) 855-0555
Fax: (650) 849-8886

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B x Non-Fee Amendment
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TRANSMITTAL FEE SHEET

Sir:

Transmitted herewith are the following for the above-identified application:

1. Return Receipt Postcard; and
2. Response to Restriction Requirement (4 pp.).

The fee has been calculated as shown below.

Claims	Claims After Amendment		Claims Previously Paid For		Present Extra	Other Than Small Entity Rate	Fee		Additional Fee ($)
Total	20	-	20			x$18.00		$	0
Indept.	2	-	3			x$84.00		$	0
First Presentation of Multiple Dependent Claims						+280.00		$	0
							Total Fee:	$	0

X No additional Fee is required.

___ Please charge Deposit Account No. **09-0108** in the amount of : $ _____

The Commissioner is hereby authorized to charge any additional fees required under 37 CFR 1.16 and 1.17, or credit overpayment to Deposit Account No. 09-0108. **A duplicate copy of this sheet is enclosed.**

Respectfully submitted,

INCYTE GENOMICS, INC.

Date: July 31, 2002

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Reg. No. 43,168
Direct Dial Telephone: (650) 845-5741

3160 Porter Drive
Palo Alto, California 94304
Phone: (650) 855-0555
Fax: (650) 845-4166